

REMARKS

I. Status Of The Claims

Claims 1-32 are pending in this application. The Examiner has withdrawn claims 8-13 from consideration, thus, claims 1-7 and 14-32 have been examined and stand rejected. Claims 1, 7, and 29-31 have been amended by this paper and as such, no new matter has been added, as discussed further below.

II. Interview Summary

Applicant wishes to thank the Examiner for the courtesy of a telephone call on October 22, 2003, at which time the Examiner and the undersigned discussed the proposed amendments outlined at p. 2 of the Office Action.

The Examiner proposes clarifying the phrase “compatibilized” by adding “total or partial solubilization or dispersion.” *Office Action* at p. 2. Applicant respectfully disagrees that this phrase is unclear when the claim is read in light of the specification. Nonetheless, to expedite prosecution, Applicant has amended independent claims 1 and 29-31 to recite “wherein said fibers are compatibilized **by a total or partial solubilization or a dispersion** with a fatty phase by at least one polyol.” Support for this amendment is found in the specification, for example, at p. 8, lines 5-7. Applicant respectfully submits that this amendment in no way narrows the scope of the claim because it makes “express what had been implicit in the claim as originally worded.” *Interactive Pictures Corp. v. Infinite Pictures, Inc.*, 274 F.3d 1371, 1377 (Fed. Cir. 2001) (affirming lower court’s finding that changing “output signals” to “output transform calculation signals” did not narrow the claim scope). The specification provides an

express definition of “compatibilized” and this amendment simply adds the express definition to the claims.

The Examiner also proposes amending “An anhydrous care or make-up” in, e.g., claims 30-31, to “An anhydrous composition in the form of make-up or care ...” *Office Action* at p. 2. Applicant can discern no reason why the phrase “An anhydrous care or make-up” is unacceptable to the Examiner and respectfully requests further clarification by the Examiner on this point.

Finally, the Examiner proposes incorporating the Markush group of polyol and fiber of claims 4 and 7 and the percent amounts of polyol and fiber into the generic claims. Based on the telephone interview, Applicant believes the Examiner’s suggestion was made in an attempt to overcome the rejection under 35 U.S.C. § 103 in view of WO 98/19652 and other cited references. Applicant respectfully submits that these amendments are not necessary for the reasons discussed below in the arguments to overcome the § 103 rejections.

III. Rejection Under 35 U.S.C. § 112

Claim 7 is rejected under 35 U.S.C. § 112, second paragraph as being indefinite. *Office Action* at p. 3. The Examiner states that “silk fiber” appears twice in claim 7. *Id.* Applicant has amended claim 7 to delete the second occurrence of “silk fiber.” Accordingly, it is believed that this rejection has been overcome. Applicant respectfully requests withdrawal of this rejection.

IV. Rejections under 35 U.S.C. § 103

In making a rejection under 35 U.S.C. § 103, the Office has the initial burden to establish a *prima facie* case of obviousness. See, M.P.E.P. § 2143. To meet this

burden, there must be some objective teaching in the prior art, coupled with the knowledge generally available to one of ordinary skill in the art at the time of the invention, that would have motivated one of ordinary skill to modify or combine reference teachings with a reasonable expectation of success in obtaining the presently claimed invention. See M.P.E.P. § 2143.01; 2143.02. Applicant respectfully submits that the Examiner in the present case has failed to meet the burden of establishing a *prima facie* case of obviousness.

Evison et al.

Claims 1-7, 14-24, and 26-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 98/19652 ("Evison et al."). *Office Action* at pp. 3-4. Applicant respectfully traverses this rejection.

According to the Examiner, Evison teaches an anhydrous cosmetic composition comprising, among other ingredients, oils, 1,3-butylene glycol, waxes, powder, and polymers such as nylon or Teflon®. *Office Action* at p. 3. Although the Examiner states that Evison does not teach waxes, etc., in the form of fibers having the claimed length or diameter, she asserts that "no criticality is seen in the particular claimed limitation ... because there are no unexpected and/or unusual results, which have been shown over Evison's invention." *Id.* at pp. 3-4.

The Examiner's remarks imply that Evison teaches that all ingredients are interchangeable, and that any combination of the disclosed ingredients are disclosed by Evison. Applicant respectfully submits that this is not so. Evison is directed to a "novel powder" produced by spray drying liquid compositions. *Evison* at p. 1, lines 4-5 and 19-20. More specifically, Evison describes a spray dried powder comprising a water

soluble matrix, which can be added to anhydrous or hydrophobic compositions. *Id.* at p. 4, lines 15-21. Evison then describes the ingredients that can be used in the spray dried powder or in the anhydrous or hydrophobic composition. For example, the spray dried powder itself can comprise at least one protein and at least one hydrolyzed starch. *Id.* at p. 5, lines 4-7. Moreover, the liquid to be used for forming the spray dried powder can comprise oils, moisturizers, (e.g., 1,3-butylene glycol), and active ingredients. *Id.* at p. 7; see *also* p. 9 line 28 to p. 10 line 3. The spray-dried powder can be mixed or dispersed with anhydrous and/or hydrophobic topical vehicles, such as oils, petrolatum and/or light liquid paraffins, and waxes. *Id.* at p. 16, lines 17-23 and p. 17, lines 1-5.

Applicant respectfully submits that to teach the claimed invention, Evison must specifically describe fibers that are compatibilized with a fatty phase by at least one polyol. Applicants, however, note that the Examiner appears to have selectively chosen the presently claimed individual ingredients from isolated passages in Evison, without any motivation to choose, and then combine these ingredients. This type of reasoning on the part of the Office has been rejected by the Federal Circuit in several cases, for example, the *Bausch & Lomb* and *Kotzab* cases discussed below.

In *Kotzab*, the Federal Circuit recognized that “[m]ost, if not all inventions arise from a combination of old elements ... every element of a claimed invention may often be found in the prior art.” *In re Kotzab*, 217 F.3d 1365, 1369-1370 (Fed. Cir. 2000). The *Kotzab* invention was directed to a process of controlling the temperature of an injection mold by using a single sensor. *Id.* at 1367. The PTO’s rejection relied on two statements in a single prior art reference. *Id.* at 1371. The court found that the PTO impermissibly viewed these two statements “in the abstract,” as opposed to being

considered in the context of the entire reference. *Id.* at 1371. In cautioning against hindsight reconstruction, the court stated:

[A] rejection cannot be predicated on the mere identification in Evans of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

Id.

Similarly, in *Bausch & Lomb*, the court found that the PTO relied on a single statement “improperly taken out of context.” *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). The court analyzed the prior art to gain a “full appreciation” of the statement and found that in the context of the subsequent sentences, this statement did not provide the requisite suggestion required to establish a *prima facie* case of obviousness. *Id.* (“The district court improperly viewed an isolated line in Caddell in light of the teaching of the ‘814 patent to hold for obviousness. This is improper hindsight analysis.”).

Applicant respectfully submits that a similar hindsight analysis has occurred here as a result of the Examiner’s picking and choosing of isolated ingredients in Evison. In reading Evison as a whole, one of ordinary skill in the art would fully appreciate that Evison describes spray dried powders that can be mixed or dispersed with an anhydrous or hydrophobic medium. The ingredients of Evison can be present in the spray dried powder itself, or in the anhydrous or hydrophobic medium. For example, the ingredients cited by the Examiner at p. 9-10 are potential ingredients for the spray dried powder, whereas the ingredients at pp. 14-15 can form the anhydrous or hydrophobic medium. The binders at p. 19 can be mixed with the spray-dried powder to

form "solid compositions of the invention." *Evison* at p. 18, lines 20-23. Without any guidance from Evison's disclosure, one cannot simply interchange ingredients for the spray dried powder with, for example, the ingredients for the anhydrous or hydrophobic medium. Such guidance is not present, and Applicant respectfully submits that the rejection is in error for such hindsight picking and choosing.

Applicant also respectfully disagrees that the only difference between the claimed invention and Evison is the recitation of "fibers." As discussed above, the present claims as amended recite compatibilization of fibers with a specific combination of ingredients, which is not taught or suggested by Evison.

Moreover, Applicant respectfully submits that the specification demonstrates the unexpected advantages of the inventive compositions. Example 1 of the specification describes a lipstick having "superior transfer-resistant properties ... compared with that of the prior art." *Specification* at p. 22. Examples 2 and 3 describe compositions that do not transfer, even under pressure. *Id.* at p. 23-24. This extent of transfer resistance is not taught by Evison. Example 4 describes a comparative experiment between a lipstick containing 5% spherical powder with a lipstick according to the invention. *Id.* at p. 25. The inventive lipstick was found to be glossier than the lipstick containing the powders. These examples demonstrate the benefits of the claimed invention. Accordingly, Applicant respectfully requests that the Examiner give patentable weight to the recitation of both the fibers, and their size, of which Evison provides no teaching or suggestion.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

Evison and Arraudeau

Claims 1-7, 14-24, and 26-32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 98/19652 ("Evison et al.") in view of U.S. Patent No. 4,659,562 ("Arraudeau"). *Office Action* at pp. 4-5. Applicant respectfully traverses this rejection.

Evison is discussed above. Arraudeau is cited for the use of fibers "because the references teach the advantageous result in the use of the similar materials in anhydrous cosmetic composition. *Id.* at p. 4.

Applicant respectfully disagrees. As argued above, Evison does not teach compatibilizing fibers with a fatty phase by at least one polyol. Arraudeau does not remedy this deficiency. Arraudeau fails to teach at least a composition comprising a fatty phase and at least one polyol, much less any compatibilization of fibers by at least one polyol. Arraudeau teaches the use of fatty body ingredients such as "representative oils" at col. 2-3, but nowhere in this list mentions polyols except in the context of esters of alcohols. Arraudeau at col. 3, lines 4-9. As argued by Applicant previously, Arraudeau does not even teach the use of polyols.¹ Thus, even if for the sake of argument Evison and Arraudeau could be combined, the combined teachings would not result in the claimed invention.

Accordingly, Applicant respectfully requests withdrawal of this rejection.

¹ The only mention of glycerol in Arraudeau is the "octanoates and decanoates of alcohols and polyalcohols, such as those of glycol and glycerol." *Arraudeau* at col. 3, lines 6-9. Thus, Arraudeau teaches the use of esters formed from glycerol, but not the use of glycerol itself.

Evison and Bara

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Evison in view of Bara et al. (U.S. Patent No. 6,177,091). *Office Action* at p. 5. Applicant respectfully traverses this rejection.

Evison is discussed above. Bara is cited for teaching “an anhydrous cosmetic composition comprising fiber, and oils, *e.g.*, parleam oil.” *Id.*

Applicant respectfully disagrees that Bara teaches the use of fiber. There is no disclosure, suggestion or teaching in Bara of the use of fibers.

As discussed above, Evison does not teach compatibilizing fibers with a fatty phase by at least one polyol. Bara does not teach fibers. Thus, there is no appreciation in either reference that compatibilizing fibers with a fatty phase by at least one polyol would achieve advantageous results.

Moreover, Bara is directed to a composition comprising an organopolysiloxane and a fatty phase comprising at least one non-volatile oil and at least one wax. In an isolated passage at col. 3, line 37, Bara discloses fatty alcohols such as octyldodecanol or oleyl alcohol. However, to arrive at the claimed combination of fatty phase and at least one polyol, one of ordinary skill in the art must pick and choose this isolated disclosure within a the long list of exemplary non-volatile oils provided by Bara at col. 3, lines 14-45, without any guidance to do so. As discussed above, the Federal Circuit has rejected this type of hindsight analysis in *Bausch & Lomb* and *Kotzab*.

Thus, Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness and respectfully requests withdrawal of this rejection.

V. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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